

## **REMARKS**

### **Amendments**

#### ***Amendments to the Claims***

Applicant has amended claims 1, 4 and 8 to correct typographic errors. Claim 8 has also been amended to clarify the language of the claim; a corresponding change has been made to claim 15. Claim 15 has also been amended to remove element numbering, to delete an unnecessary element, and to replace text that was inadvertently omitted in the response to the February 25, 2005 Office Action. No new matter has been added as a result of these amendments.

### **Rejections**

#### ***Rejections under 35 U.S.C. § 103***

#### **Claims 1, 2, 4, 8-14, 16-19, 21, 23-26, 28, 29, 31 and 33-35**

Claims 1, 2, 4, 8-14, 16-19, 21, 23-26, 28, 29, 31 and 33-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kahn, et al., U.S. Patent 6,029,046 (previously cited). Applicant draws the Examiner's attention to the fact that claim 17 was cancelled in the response mailed October 17, 2005 and is therefore no longer pending in the present application.

The Examiner admits that Kahn does not teach or suggest a tuner dedicated to receive only a single media content channel and asserts Official Notice that it is well-known to include multiple tuners in a device. The Examiner also states that it is well-known to "include[ing] a dedicated tuner" in a device that has multiple tuners. The Examiner further asserts that it would thus be obvious to modify Kahn to include multiple tuners, one of which would be a dedicated tuner, to allow faster and concurrent processing of data channels.

Applicant respectfully objects to the Examiner's statement that it is well-known to include a dedicated tuner in a device that has an existing tuner that can tune to multiple channels. Assuming one of skill in the art would be motivated to include a second tuner in Kahn's game adapter, the Examiner has provided no rationale as to why that person would include a dedicated tuner instead of including another multiple channel tuner.

Indeed, including another multiple channel tuner would provide more flexibility in channel selection. Accordingly, Applicant challenges the Examiner cite references in support of his assertion of Official Notice [MPEP: 2144.03(C)].

Furthermore, Applicant respectfully submits that it is not obvious to modify Kahn's game adapter to include a dedicated tuner in addition to the existing multiple channel tuner. Kahn's game adapter may receive data for multiple games but it actually processes only the data that corresponds to the game selected by the user [Kahn: col. 7, line 61 through col. 8, line 6]. Thus, Kahn does not suggest any advantage in adding a dedicated tuner to the existing multiple channel tuner. Therefore, the Examiner's statement that adding the dedicated tuner would allow faster and concurrent processing is not supported by Kahn. Moreover, there is no reasonable expectation that the modified game adapter would result in faster processing of the selected game data since there is nothing in Kahn that suggests concurrent processing of game data. Thus, there is no reasonable expectation of success that Kahn could process data faster if Kahn is modified as suggested by the Examiner [MPEP: 2143.02].

Accordingly, Applicant respectfully submits that Applicant's invention as claimed in claims 1, 2, 4, 8-14, 16, 18, 19, 21, 23-26, 28, 29, 31 and 33-35 is not rendered obvious by Kahn, and respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103(a).

### **Claim 3**

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kahn in view of Strubbe, et al., U.S. Patent 5,483,278 (previously cited).

As discussed above, Khan does not teach or suggest Applicant's invention as claimed in claim 1, from which claim 3 depends. Strubbe contains no disclosure related to any type of tuner, much less a dedicated tuner as claimed in claim 1. Therefore, the combination cannot render obvious Applicant's invention as claimed in claim 3 and Applicant respectfully requests the withdrawal of the rejection of the claim under 35 U.S.C. § 103(a) over the combination of Kahn and Strubbe.

### **Claims 5 and 6**

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kahn in view of Sata et al., U.S. Patent 5,134,499 (previously cited).

Khan does not teach or suggest Applicant's invention as claimed in claim 4, from which claims 5 and 6 depend. Sata discloses a video recording device with independent read/write heads but not a dedicated tuner as claimed in claim 4. Therefore, the combination cannot render obvious Applicant's invention as claimed in claims 5 and 6 and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination of Kahn and Sata.

#### **Claim 7**

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kahn and Sata, in further view of Gerba, U.S. Patent 5,931,908 (previously cited).

As discussed above, the combination of Khan and Sata does not teach or suggest Applicant's invention as claimed in claim 5, from which claim 7 depends. Gerba discloses overlaying a user interface over audiovisual content and does not teach or suggest a dedicated tuner as claimed. Therefore, the combination cannot render obvious Applicant's claim 7 and Applicant respectfully requests the withdrawal of the rejection of the claim under 35 U.S.C. § 103(a) over the combination of Kahn, Sata and Gerba.

#### **Claims 15 and 20**

Claims 15 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kahn in view of Doorhein, et al., U.S. Patent 6,078,360 (previously cited).

As discussed above, Khan does not teach or suggest the invention as claimed in claims 8 and 16, from which claims 15 and 20 depend, respectively. Doorhein discloses transmitting control data in a television signal but does not teach or suggest a dedicated tuner as claimed in claims 15 and 20. Therefore, the combination cannot render obvious Applicant's invention as claimed in claims 15 and 20 and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination of Kahn and Doorhein.

#### **Claim 22**

Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kahn in view of Lawler, et al. U.S. Patent 5,805,763 (previously cited).

As discussed above, Khan does not teach or suggest Applicant's invention as claimed in claim 16, from which claim 22 depends. Lawler discloses an interactive television viewing system but does not teach or suggest a dedicated tuner as claimed in

claim 16. Therefore, the combination cannot render obvious Applicant's invention as claimed in claim 22 and Applicant respectfully requests the withdrawal of the rejection of the claim under 35 U.S.C. § 103(a) over the combination of Kahn and Lawler.

**Claim 27**

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kahn in view of Gerba.

As discussed above, Khan does not teach or suggest Applicant's invention as claimed in claim 16, from which claim 27 depends. Gerba discloses overlaying a user interface over audiovisual content and does not teach or suggest a dedicated tuner as claimed in claim 16. Therefore, the combination cannot render obvious Applicant's invention as claimed in claim 27 and Applicant respectfully requests the withdrawal of the rejection of the claim under 35 U.S.C. § 103(a) over the combination of Kahn and Gerba.

**Claim 30**

Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kahn and Sata in further view of Krause, U.S. Patent 6, 304,714 (previously cited).

As discussed above, the combination of Khan and Sata does not teach or suggest Applicant's invention as claimed in claim 5, from which claim 30 depends. Krause discloses providing simultaneous video playback and recoding integrated into a single set-top box but does not teach or suggest a dedicated tuner as claimed. Therefore, the combination cannot render obvious Applicant's invention as claimed in claim 30 and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over the combination of Kahn, Sata and Krause.

### **SUMMARY**

Claims 1-16, 18-31 and 33-35 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-8300 x3476.

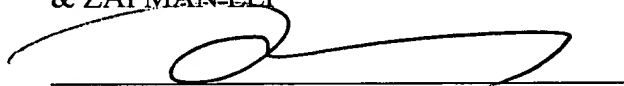
### **Deposit Account Authorization**

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR  
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Dated: August 21, 2006



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